

permit." Each of claims 1-6 and 8 contain the expression or phrase "said composition being compacted to an optimum density of not less than approximately 1.033 g/cc." This phrase is manifestly not indefinite in spelling out to those skilled in the art that the claimed composition is compacted to a density of not less than approximately 1.033 g/cc. It is well established that terms of a claim carry "their ordinary meaning, unless it appears that the inventor used them differently." Gargoyles, Inc. v. United States, 28 USPQ2d 1715, 1716-17 (Fed. Cir. 1989). The term "optimum" as employed in the claims herein is defined in Hackh's Chemical Dictionary, a standard reference book, as meaning "best" or "most favorable." Thus, those skilled in the art would clearly interpret the claim language as spelling out that the best or most favorable results are obtained when the claimed composition is compacted to a density of not less than approximately 1.033 g/cc. The recitation of the specific density level considered as optimum clearly provides the degree of precision and particularity circumscribed by the claims at issue. In rejecting a claim under Section 112, second paragraph, an Examiner must establish that one of ordinary skill in the pertinent art would not have been able to ascertain with a reasonable degree of precision and particularity the specific area set out and circumscribed by the claim. Ex parte Wu, 10 USPQ2d 2031, 2033 (B.P.A.I. 1989), In re Moore, 169 USPQ 236, 238 (CCPA 1971). In the light of the factors discussed above, it is respectfully submitted that the Examiner has failed to make out a *prima facie* case of indefiniteness with respect to the term "optimum."

The Examiner has also asserted that the term "purified cellulose" is indefinite under 35 U.S.C. 112, second paragraph. Here again, applicants respectfully traverse the rejection and in

connection with such traversal, refers the Examiner to the attached Declaration Under 37 C.F.R. 1.132 of Ronald O. Richardson, one of the co-inventors of the present invention. As attested to by Mr. Richardson, the term "purified cellulose" as used herein would be understood by those skilled in the art as referring to cellulose subjected to hydrolysis and purification and differing from microcrystalline cellulose. In support of this statement, reference is made to the attached copy of a brochure published by FMC, a supplier of microcrystalline cellulose and purified cellulose under the trademarks AVICEL, LATTICE and NILYN.

Under 35 U.S.C. 112, second paragraph, claims are to be construed by those of ordinary skill in the art. Schenck v. Norton Corp., 218 USPQ 698, 701-02 (Fed. Cir. 1983). Thus, a claim is indefinite where those skilled in the art would not understand what is claimed when reading the claim language in light of the specification and prosecution history. Ex parte Sareman, 27 USPQ2d 1472, 1473-74 (B.P.A.I. 1993). In the present instance, it is respectfully submitted that one of ordinary skill in the art would have no difficulty in understanding the scope and meaning of "purified cellulose" in the context of the present invention as described in the specification.

Accordingly, based upon the foregoing including Mr. Richardson's Declaration, it is submitted that the rejection of claims 1-6 and 8 under 35 U.S.C. 112, second paragraph, should be withdrawn since these claims do particularly point out and distinctly claim the subject matter which applicants regard as their invention.

The rejection of claims 1-8 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Richardson et al. U.S. Patent No. 6,416,752 is

respectfully traversed. Applicants respectfully submit that the present invention, as defined in claims 1-8 is not fully disclosed under 35 U.S.C. 102(e) or, in the alternative, rendered obvious under 35 U.S.C. 103(a) by the Richardson et al. reference.

The present invention is directed to a composition in compacted form for use for termite monitoring and control comprising a specified cellulose material as a base bait, the composition being compacted to an optimum density of not less than approximately 1.033 g/cc. Through the present invention, applicants have discovered that by compacting such a composition to an optimum density of not less than approximately 1.033 g/cc, maximum loading of termite bait stations may be achieved resulting in an extension of the time period needed for monitoring and filling the bait stations. The practice of the present invention permits substantially greater loading of monitoring and control bait into current commercially available termite bait stations than current commercial baits. In this regard, reference is made to paragraph 3 of Mr. Richardson's attached Declaration and the attached brochure which includes Fig. 1 and Fig. 3 photographs showing three tablets in a tube or cartridge, these tablets having been prepared in accordance with the present invention and containing a total of at least 93 grams of a bait composition as defined in claim 1 of this application. If a non-compacted bait composition were used, it would only require 30 grams to fill the same tube or cartridge. The present invention thus maximizes the amount of bait which may be loaded into a termite bait station by reason of being compacted to an optimum density of not less than 1.033 g/cc.

As also shown by the tabletting studies set forth in the specification herein, the optimum (or most favorable)

compaction/density parameters for the compositions of the invention include a density of approximately 1.196 g/cc, an area compaction pressure of 688.71 kg/cm², a compaction pressure of 10,000 lbs. and a compaction ratio of 3.32.

The Richardson et al. '752 patent is directed to an improved termite bait composition comprising a powdered cellulose attractant having a particle size in the range of approximately 1 to 100 micrometers and a termite killing agent. In accordance with the disclosure of this reference, by using powdered cellulose material of this small particle size as an attractant, it has been found that the resulting termite bait composition leads to increased ingestion since the termites may more easily ingest material of this small particle size. The reference (col. 2, lines 65-67) contains a general disclosure that the termite bait composition may be compressed into tablets without providing any information whatsoever as to the density to be achieved or what degree of compaction is required to obtain the most desired composition in compacted form.

Notwithstanding the failure of the Richardson et al. reference to provide any clue as to the improved results obtainable when a bait composition is compacted to an optimum density of no less than approximately 1.033 g/cc, the Examiner asserts that in Richardson et al. the "bait is compressed into tablets (col. 2, lines 65-68) thus would inherently achieve at least the density of cellulose, and is of optimum density for operation as a bait" (emphasis added). The Examiner's reliance upon inherency is misplaced because the reference does not provide any information whatsoever respecting compaction, much less the degree of compaction specified in claims 1-8. Thus, the rejection of claims 1-8 as anticipated by Richardson et al. cannot stand. As held by the Federal Circuit in In re Robertson,

49 USPQ2d 1949 (Fed. Cir. 1999), an element of a claim is not "inherent" in the disclosure of a prior art reference unless extrinsic evidence shows that missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherency may not be established by mere probabilities or possibilities and the mere fact that a certain thing may result from a given set of circumstances is not sufficient. See also Continental Can Co. v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) and In re Oelrich, 212 USPQ 323 (CCPA, 1981). In the present instance, the concept of compaction and the degree of compaction necessary for optimum results is clearly missing from Richardson et al. and persons of ordinary skill in the art would not recognize such missing material from a reading of the Richardson et al. disclosure. And no extrinsic evidence has been cited by the Examiner to show that the missing matter is necessarily present in the actual description in the reference.

As to the rejection of claims 1-8 as obvious over the Richardson et al. reference under 35 U.S.C. 103 (a), such rejection must also fall as based upon inherency. In connection with this ground of rejection, the Examiner acknowledges that Richardson et al. does not expressly identify "maximum density" but contends "one would find it obvious to meet the requirement for particle size of 1-100 micrometer (col. 2, lines 23-38) with simple testing to insure compression strength at less than that which would agglomerate particles, and thus fall within range of instant claim 7." This rejection is thus plainly based upon hindsight rather than upon any information gleaned from or knowable from the Richardson et al. reference. As stated by the Federal Circuit in W. L. Gore & Assocs. v. Garlock, Inc., 220 USPQ 303, 312-313 (Fed. Cir. 1983):

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

This statement is particularly apt to the present situation in which the Richardson et al. reference conveys no knowledge regarding compaction, much less the advantages flowing from compacting cellulose material to an optimum density of not less than approximately 1.033 g/cc.

The Examiner's above-quoted contention also conveniently overlooks the lack of any teaching or suggestion in Richardson et al. of the desirability of compacting a cellulose material or the importance of optimizing such compaction. Here again reference is made to the third paragraph of Mr. Richardson's Declaration which graphically illustrates the manner in which the present invention maximizes the amount of bait which may be loaded into a termite bait station, this feature being entirely outside the Richardson et al. reference disclosure either on the basis of actual disclosure or inherency.

Finally, the Examiner's position ignores the established principle that inherency and obviousness are distinct concepts. Thus, in In re Spormann, 150 USPQ 449 (CCPA 1966), the Court of Customs and Patent Appeals observed that (at 452):

"the Board apparently thought that the minimizing of sulfate production would be inherent in the process of Frederich et al...As we pointed out in In re Adams...., the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known.



WMMG 3545
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Obviousness cannot be predicated on what is unknown."

Accordingly, the Examiner's contention based upon inherency cannot stand because there is no supporting teaching in the prior art.

For all of these reasons, claims 1-8 are submitted to define subject matter which is both novel and non-obvious under 35 U.S.C. 102(e) and 103(a), respectively, and the Examiner's rejection of these claims should therefore be withdrawn.

Favorable reconsideration and early allowance of claims 1-8 are respectfully requested.

Respectfully submitted,

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CERTIFICATE OF MAILING

I certify that this Letter to the Patent and Trademark Office in the application of Jeffrey A. Martin et al., Serial No. 10/059,564, filed January 29, 2002 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on this 17th day of February, 2004.

Cindy A. Ard

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